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BANNER & WITCOFF, LTD.  
28 STATE STREET  
28th FLOOR  
BOSTON, MA 02109-9601

EXAMINER

ROSE, SHEP K

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 05/19/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/840884

Applicant

MONTGOMERY

Examiner

SILVER ROSE

Group Art Unit

1614

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period of Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 2/10/03 response
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 15 29 is/are pending in the application.
- Of the above claim(s) 28 29 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 156 8227 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 28 29 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Newly presented Claims 28 and 29 and claim 18 are with drawn, Rule 142(B) as non-elected.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3 to 6, 8 to 16 stand are rejected under 35 U.S.C. 102(b) as being anticipated by each of:

Makagawa et al U.S. 3901819 (8/75) describing anhydrous dry granules of triacetin (glyceryl triacetate) ("GTA") with sodium percarbonate or hydrogen peroxide, surfactants, chelating agents. See: claims 4, 5, 13, and 15, example 3, granules, column 2, lines 30 to 52.

Jones U.S. 3956159 (5/76), anhydrous liquid bleach comprising "GTA" (glyceryl triacetate), (claim 1) pH buffer (claim 12), column 4, lines 21 to 37, chelating agents 1 column 4, lines 1 to 20).

Green et al U.S. 4,772,412 (9/88), glyceryl triacetate "GTA", (column 9, line 26) in non-aqueous liquid carriers (claim 1) with sodium perborate, surfactants and chelating See: column 6, lines 1 to 43.

Barnes U.S. 4981606 (1/91), glyceryl triacetate, ("GTA") with sodium perborate, surfactants, sequestrates, etc. See: col. 2, lines 58-60, column 8, line 11 is anhydrous liquids.

Kong et al U.S. 5505740 (4/96), describe glyceryl triacetate, ("GTA"), Table 3, column 18, with hydrogen peroxide source in encapsulated, coated dry tablets, at columns 11 and 12, with surfactants, buffers, optimized to alkaline pH.

Composition claims 1 and 3 to 6, 8 to 16 differ from these prior bleaching compositions (dry granules or anhydrous liquids) comprising glyceryl triacetate, an encompassed acetic acid ester of glycerin, (claim 3 Markush group) and encompassed species of peroxide sources (claim 4 Markush group) described with anhydrous dry granule or liquid carriers (claim 8 Markush group); thickening agents (claim 10 Markush group); buffer (claim 12 Markush group); surfactant (claim 14 Markush group); and chelating agents (claim 16 Markush group); only by a statement of intended use in the preamble of these otherwise old bleach compositions, herein intended as an oral care composition for whitening teeth. They inherently function to bleach laundry, as taught by this prior art. A statement of intended new use cannot impart patentable novelty on otherwise old composition. The only oral care components not found in the old bleach compositions are in dependent claim 17 "flavorants and sweeteners" but both can be found in an encompassed species of oral care compositions, namely denture cleansers, for whitening an encompassed species of teeth, namely false teeth.

The only carriers recited in dependent claim 8 not found in prior art bleach compositions are the non-elected chewing gum and dental floss species.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 17 to 27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gaffar et al or McLaughlin who whiten teeth with peroxide precursor without an acetic acid ester of glycerin (details herein below) taken with anyone of each of Nakagawa et al, Jones Green et al, Barnes, and Sanderson et al each admittedly enhancing peroxide bleach with an acetic acid ester of glycerin (details above), the prior clearly analogous bleach art describing GTA and peroxide precursors in anhydrous systems, as noted above. Gaffar et al and McLaughlin describe prior art dual component tooth whitening systems with flavors or sweeteners keeping hydrogen peroxide (or its precursors) in one component, and, admittedly neither mentioning applicant's acetic esters of glycerin to be among their described species of peroxide activators/catalysts, but the analogous prior bleach art, as noted above, does describe this benefit or property for "GTA", glyceryl triacetate, with encompassed species of hydrogen peroxide precursors. It remains entirely in accordance with the prior art concepts of McLaughlin and Gaffar et al for tooth whitening systems to replace their explicitly described species of peroxide activators/catalysts with other known species of

peroxide activators/catalysts, including the "GTA" (glyceryl triacetate), ("triacetin") species of peroxide activator/catalyst described as such by each of Nakagawa et al. Jones, Green et al, Barnes and Sanderson et al, and to thereby keep it apart from the peroxide or peroxide precursor.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 19 to 27 are no longer rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 of U.S. Patent No. 6,221,341, since the terminal disclaimer of it has been filed. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope to substantially the same inventions.

This application is a continuation, and not a divisional application filed as a result of any USPTO requirement under 35 USC 121 to restrict the claims of the parent application Serial No. 09/196403, filed November 19, 1998, now U.S. Patent No. 6,221,341, whose two claims are drawn to the same method for whitening teeth with "GTA" (glyceryl triacetate) and the same encompassed species of hydrogen peroxide as

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presented in method of whitening claims 19 to 27 herein, presented a clear issue of obviousness-type double patenting, in the absence of an accepted terminal disclaimer

Montgomery et al U.S. 6162055 claim tooth-whitening methods, which in claims 8 to 12 therein employ peroxides like hydrogen peroxide or peroxyacids like peroxy acetic acid. Column 9, lines 2 to 13 contemplate "GTA", glyceryl triacetate, a peroxy acid precursor may be in a separate phase from (page 8, lines 57 to 66) an oxidizing phase including, but not limited to, hydrogen peroxide, carbamide peroxide, alkali metal peroxides, and peroxyacetic acid.

Montgomery U.S. 5922307 (claims 1, 47) claims a tooth surface bleaching method comprising hydrogen peroxide 10% water, a thickening agent, on alkaline pH adjusting agent, and a calcium-chelating agent, with a bleaching pH of 6.0 to 10.0.

Montgomery U.S. 5908614 (claim 1 to 9), claims 1, 2 and 5 to dry non-aqueous substantially water free chewing gum, pH 4 to 6.5, and coated sodium percarbonate hydrogen peroxide precursor, and method claims 4, 7, and 9 to their oral administration to the oral cavity of an animal.

Claims 19 to 27 are no longer rejected under the judicially created doctrine of obviousness-type double patenting in view of the terminal disclaimer, as being unpatentable over claims 8 to 12 of U.S. Patent No. 6,221,341 in view of Nakagawa et al, Jones, Green et al, Barnes and/or Sanderson et al (details above) in view of anyone of which it is obvious to one of ordinary skill in the art, that the addition of "GTA" (glyceryl triacetate) to expectedly boost the peroxide or peroxide precursor would not

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only be motivated, but there would also be a reasonable likelihood of success, especially in the absence of evidence to the contrary.

Claims 19 to 27 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 7 of U.S. Patent No. 5,922,307 in view of Nakagawa et al, Jones, Green et al, Barnes and/or Sanderson et al (details above) in view of anyone of which motivation is evident to include "GTA" (glyceryl triacetate) for its expected "boost" to the activity of the hydrogen peroxide or hydrogen peroxide precursor, with a reasonable likelihood of success, especially in the absence of evidence to the contrary. No terminal disclaimer is filed, and counsel presents arguments why not.

Claims 1, 3, 4, 5, 7, 8, 11, 12, 17, 19, to 27 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5, 7, 9 of U.S. Patent No. 5,908,614 in view of Nakagawa et al, Jones, Green et al, Barnes and/or Sanderson et al (details above) in view of anyone of which motivation is evident to include "GTA" (glyceryl triacetate) in the anhydrous chewing gum, for its expected "boost" to the activity of the coated sodium percarbonate hydrogen peroxide precursor especially in the absence of evidence to the contrary. No terminal disclaimer has been filed but counsel presents arguments why not.

A terminal disclaimer and fee has been filed for patent 6,221,341, but none filed for applicants for applicant's patent 5,908,614, (and non-persuasion arguments presented for not filing one.) and non-filed for applicant's patent 5,922,307, (same arguments).



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Glyceryl triacetate and a hydrogen peroxide precursor are in claims 1 and 2 of U.S. 6,221,341, (priority data November 19, 1997).

The assignee is Ora Ceutical, LLC.

Montgomery 5,908,614 (no assignment displayed) is to Robert Eric Montgomery (A.K.A. R. ERIC MONTGOMERY, herein), and the remarks do not controvert that the same inventor's patent's compositions claims recite a dry non-aqueous substantially water free carrier, for alkalis metal, or sodium percarbonate, hydrogen peroxide precursor, in herein non-elected chewing gum, or that members of the claim 8 herein Markush group of anhydrous carriers: chewing gum, oils, waxes and esters, as well as stearic acid esters of claim 10 herein, are encompassed by the patent claims: oils, fatty esters, etc.

A review of the specification as filed (See page 3) reveals the technical problem presented by generally more intractable intrinsic tooth Staining, as more difficult to remove than extrinsic tooth staining, but although both types of stains are herein to be removed or destroyed, neither type of stain, (intrinsic or extrinsic) is required to be present on, removed, or destroyed in the "teeth whitening" claims 19, 20, 21, 22 to 27.

The remarks of counsel on page 5 state that the cited patents fail "each of the two-step two prong test": they are "not within the field of applicant's endeavor", and (2) "they are "not reasonably pertinent" to "the particular problem with which the applicant is in solved".

Counsel, who is not qualified as an expert, argues further that "cleaning laundry is a "different field of endeavor" from oral care products" and also "Regarding the first

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prong, it “cannot” be “credibly argued” that the cited patents disclosing compositions for bleaching or otherwise cleaning clothing “or hard surfaces” are not a “different field of endeavor” from oral care products.

Regarding the second prong, none of the “teeth” claims (as noted above) recite and require the removal of any stains from teeth within the oral cavity, no intrinsic stain (the technical problem), no extrinsic stain.

It is argued, by counsel, who has not qualified as an expert that “vastly different problems in disparate fields” are involved in “the laundry bleaching compositions of the cited patents” and applicant’s claimed “tooth bleaching composition”.

In the absence of a Rule 132 Declaration of an expert, or of applicant, the Late Giles Rich, a co-author of the Title 35 Patent Statute has stated in written opinions that “the concept of a “non-analogous art” has” fallen by the wayside! The test is rather if one skilled in the art was confronted by this technical problem, would they go to the analogous art for a solution to the problem?

In the absence of a Rule 132 Expert’s opinion not only are arguments of counsel not entitled to any weight, (and the only one to be “pronged” (herein) would appear to be applicant!).

The clear rebuttal to this argument of counsel, as well as they very narrow reference in the specification to the quite clearly related bleach art appears on page 5, lines 8 to 13 down to page 6, line 9.

It is believed that hydrogen peroxide destroys tooth chromogens in a similar fashion to that observed in the destruction of laundry stains...oxidizing... bonds found in

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the stain molecules. A related class of compounds, the peroxyacids, has been used in laundry detergents to effectively whiten clothes .. (with) in stain molecules... "laundry detergent"... "wash solution" "clean the clothes being washed" "wash water during the laundry cycle" "may more effectively clean clothing."

A full rebuttal, in the absence of any Rule 132 expert declaration for the record herein, is that many patents to such stain removal by non-aqueous peroxide bleach assisted by such an acetic acid ester of glycerin, also include stain removal from inanimate hard surfaces,: ceramic dishware, bathroom tile, dentures (false teeth), (within the scope of the "teeth" in the method claims).

Remarks have been considered, but are not seen as a substitute for a Rule 132 Declaration of an expert, when counsel is arguing technical facts. Attorney argument is not evidence, unless it is an admission. See: In re De Blauwe, 222 USPQ 191, 196; Meitzner v. Mindick, 193 USPQ 356, 358; In re Schalze, 145 USPQ 716, 718; In re Cole, 140 USPQ 230, 233, and In re Walters, 77 USPQ 609, 610.

It is not the Examiner's suggestion that it is "reasonable" to lower and firmly hold an individual with stained teeth into a washing machine filled with such bleach and stained laundry, or tossed into a dishwasher, with coffee or tea stained cups and stain removing bleach peroxides until their "teeth" are "whitened," as white as laundry, or even to toss their stained dentures (and stained removable dental prosthesis) into the wash cycle of the laundry washing machine, or a dishwasher, but that it remains the policy of the USPTO is to give no weight to the preamble of a composition claim.

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New (and non-elected) claims 28 and 29 (chewing gum and dental floss) may not be carriers for laundry and inanimate hard surface and denture stain removal bleach, but the Markush group of claim 8 carriers is met by glycerin, propylene glycol, polyethylene glycol, oils, waxes and esters “which are well-known common non-aqueous carriers for such stain whitening inanimate surface cleansers, thickened with the thickening agents of claim 10.”

Pages 12 and 13 of the August 15, 2002 response to the election of species requirement may include a flavorant as in claim 17 as noted above, but the election doesn't include non-elected claims 28 and 29 (to chewing gum and dental floss,) and the election is not accompanied by any amendment to the independent composition claims requiring (as elected) any flavorant, and the “teeth” whitening method claims read on stained dentures and stained removable dental prosthesis, which, as inanimate surfaces, are encompassed by the stained inanimate surface bleach art argued by counsel to be “non-analogous”.

If applicant were to file a Rule 132 Declaration as an expert, it could buttress the counsel's argument concerning the argued non-analogous laundry and hard inanimate surface stain removal bleach art and the tooth whitening art (by the same bleaching means), and his Rule 132 Expert opinion, if presented, (to buttress argument of counsel), would appear to be entitled to weight, but may well be in consistent with the recitals of page 5, line 11 et seq. of the specification as filed, unless the inconsistency, can be convincingly explained, and the teeth whitening method claims were to be appropriately amended, as suggested, -- intrinsic tooth stain removal in the oral cavity --

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, and – flavors or sweetener – added to the elected composition, to distinguish from “laundry bleach”.

Applicant’s assistance is hereby requested in the following matter.

An applicant name search has been performed (in the Palm Internal USPTO Database) since the USPTO Examiners are tasked to perform “ODP” (obvious double patenting grounds of rejection) and this is the only tool available. Applicant’s assistance is required.

The entry “Montgomery, Robert Eric” produces 3 U.S. Patents: 5922307, 6,312,670 and 6,162,055 and a confidential number of pending U.S. applications, (no patents yet).

The entry “Montgomery, R. Eric” Produces a different and confidential number of pending U.S. applications, and 7 different U.S. patents: 5,944,528, 6,331,292, 6,221,341, 6,281,265, 6,322,773, 6,479,037 and 6,475,469.

The entry “Montgomery, Robert E.” produces a different and confidential number of pending U.S. applications and different U.S. patents.

The entry “Montgomery, Robert” produces a differed and confidential number of pending U.S. application and different U.S. patents.

A sole applicant, namely R. Eric Montgomery, has filed this application. The USPTO Examiners, who is tasked to perform obvious type double patenting grounds of rejection, requires applicant’s assistance, since it has come to the USPTO Examiner that this applicant not only has multiple patent attorneys – in California, New York, Boston and now Chicago, and multiple assignees, but also has filed patent applications

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with multiple names, for example, Robert Montgomery, Robert E. Montgomery, R.E. Montgomery, and herein R. Eric Montgomery !!

The only tool available for the USPTO Examiner to perform this task is an applicant inventor name search in the PALM (Internal USPTO) Date Base.

To the Examiner's dismay, applicant's applications filed under Eric Montgomery, and vice versa, the applicant's applications in the Robert Montgomery file do not pick up applications filed as Eric Montgomery, or herein, as R. Eric.

Please send copies of all of applicant's applications and Montgomery patents that relate to such acetic acid esters of glycerin.

The only original composition claim presented seen to distinguish from anhydrous laundry bleach carriers with the same peroxide sources and the same glycerin acetic acid esters is claim 17, to further comprising flavorants or sweeteners.

Why not recite both?

From the teachings of the "GTA" peroxide bleach references, it was apparent that one of ordinary skill in the art would not only be motivated, but would have had a reasonable expectation of success in producing the claimed invention. Therefore the invention as a whole was prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shep Rose whose telephone number is 308-4609. The examiner can normally be reached on Monday, Tuesday and Thursday from 7:30 AM to 6 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Rose/LR

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**SHEP K. ROSE  
PRIMARY EXAMINER**